

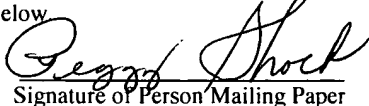
PATENT

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November 23, 2005

Date of Deposit

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number: 10/017,728
Filing Date: 12/14/2001
Applicant(s): Joshua S. Auerbach, et al.
Entitled: MESSAGE FILTERING
Examiner: Blair, Douglas B.
Group Art Unit: 2142
Attorney Docket No.: GB920010099US1 (7161-186U)

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants request that a Panel Review of the rejections in the Final Office Action dated August 23, 2005, be performed in the above identified application.

REMARKS

CLAIMS 1-15 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON

HERZ

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference.¹ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.² This burden has not been met.

The Examiner's statement of rejection in First Office Action dated March 1, 2005 (hereinafter First Office Action) reproduces entire paragraphs of the claims and asserts that all the limitations in the particular paragraph are disclosed by certain cited passages within Herz. Although broadly identifying within Herz where the Examiner believes the claimed limitations are disclosed, the statement of the rejection fails to clearly identify many of the specific elements within Herz being relied upon in the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).³

By failing to specifically identify those feature within Herz being relied upon in the rejection, the Examiner has essentially forced Applicants to engage in mind reading to determine how the Examiner is interpreting the elements of the claims and what features the Examiner

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

² Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., *supra*.

³ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

believes identically disclose the claimed invention. Any continuing disagreement between Applicants and the Examiner as to whether a particular claimed feature is disclosed by Herz is a direct result of a lack of specificity by the Examiner in the statement of the rejection. Moreover, the only comments (i.e., the ¶ spanning pgs. 2 and 3) made by the Examiner in the Final Office Action responsive to Applicants' prior arguments do little to clarify the Examiner's analysis.

Failure to teach "said [subscription] request including a filter expression"

On pg. 2 of the First Office Action, the Examiner asserted that the claimed subscription request having a filter expression that includes at least one attribute is disclosed in column 57, lines 6-51 of Herz. On pg. 8 of the Amendment filed June 1, 2005 (hereinafter Amendment), Applicants disagreed that the above-identified feature is disclosed by Herz. Furthermore, Applicants argued in the ¶ spanning pgs. 8 and 9 that "the term 'target profile' has been analogized to the 'filter' ... however, ... the target profile of Herz is 'computed' for a 'new article' ... [t]he target profile is not extracted from a subscription request." The Examiner responded to these arguments in the ¶ spanning pgs. 2 and 3 of the Final Office Action by referring specifically to column 56, lines 21-25 of Herz and asserting that:

search profiles mentioned in the cited portion of Herz are considered a subscription request because they allow the user to specify keywords and target objects to request publications that may be of interest.

Examiner confusing "specifying search parameters" with "subscription request"

The teachings within Herz referred to by the Examiner are clearly directed to specifying search parameters (i.e., "specify keywords and target objects"). However, the Examiner has asserted that specifying search parameters is comparable to the claimed subscription request without putting forth any analysis as to why one skilled in the art would construe the meaning of

the claimed term "subscription request" in such a manner so that the teaching within Herz of specifying search parameters would identically disclose this claimed feature.

Not only has the Examiner failed to establish why one skilled in the art would consider Herz's teaching of "specifying search parameters" and the claimed "subscription request" as being comparable, Herz differentiates between a request for information (i.e., a subscription) and specifying search parameters. Referring to column 57, lines 18-24, a search profile is stored in a local data storage medium on a proxy server S₂, and when a user requests access to "news" at step 1102, a profile matching module 203 considers each search profile in the user's search profile set. Therefore, Herz teaches that a search profile (i.e., the Examiner's asserted "subscription") and a request for information are separate and distinct. In contrast, the claimed invention recites that the subscription request includes a filter expression.

Failure to teach "mapping at least part of an attribute to a generic format"

On pg. 2 of the First Office Action, the Examiner asserted that the above-identified feature is disclosed in column 56, lines 29-48 of Herz. On pg. 8 of the Amendment filed June 1, 2005 (hereinafter Amendment), Applicants disagreed that the above-identified feature is disclosed by Herz. The Examiner responded to this arguments in the ¶ spanning pgs. 2 and 3 of the Final Office Action by stating "[t]he rest of the cited portion of Herz reads on the generic filtering system claimed by applicant."

At the outset, Applicants note that the claims are not directed to a "generic filtering system," as asserted by the Examiner. Instead, Applicants are claiming mapping at least part of an attribute to a generic format. This feature is discussed, for example, in pg. 18, lines 7-12 of Applicants' disclosure. Upon reviewing the cited passage, Applicants are unable to determine what features the Examiner believes identically discloses the above-identified claimed limitation.

The Examiner's response in the Final Office Action also does not clarify this ambiguity. In this regard, the Examiner's rejection under 35 U.S.C. § 102 fails to comply with 37 C.F.R. § 1.104(c).

Failure to teach "subscription request of a first type" vis-à-vis "publication message of a second type"

On pg. 2 of the First Office Action, the Examiner merely reproduced both of the above limitations and asserted that these limitations are respectively disclosed in column 57, lines 6-51 and column 56, lines 29-48 of Herz. Upon reviewing these cited portions of Herz, however, Applicants are unable to determine where Herz separately teaches a first type and a second type.

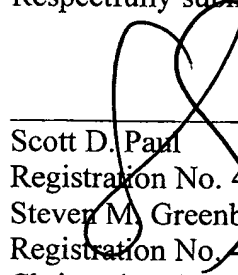
Failure to teach several other claimed features

In the ¶ spanning pgs. 8 and 9 of the Amendment, Applicants argued that several other claimed features were not disclosed by Herz. However, the Examiner's "Response to Arguments" spanning pgs. 2 and 3 of the Final Office Action never addresses these arguments.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 23, 2005

Respectfully submitted,



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